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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/656,715  | 09/07/2000  | Tomoaki Hokao        | Q60731              | 1378             |
| 23373   | 7590        | 05/28/2004           | EXAMINER            |                  |
| SUGHRUE MION, PLLC<br>2100 PENNSYLVANIA AVENUE, N.W.<br>SUITE 800<br>WASHINGTON, DC 20037 |             |                      | FERRIS, DERRICK W   |                  |
|   |             | ART UNIT             |                     | PAPER NUMBER     |
|   |             | 2663                 |                     | 9                |
| DATE MAILED: 05/28/2004   |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                  |
|------------------------------|-------------------------------|------------------|
| <b>Office Action Summary</b> | Application No.               | Applicant(s)     |
|                              | 09/656,715                    | HOKAO, TOMOAKI   |
|                              | Examiner<br>Derrick W. Ferris | Art Unit<br>2663 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 27 April 2004.  
 2a) This action is **FINAL**.                            2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-33 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) 14 is/are allowed.  
 6) Claim(s) 1-12 and 15-33 is/are rejected.  
 7) Claim(s) 13 is/are objected to.  
 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on 07 September 2000 is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Amendment*

1. **Claims 1-33** as amended are still in consideration for this application. Applicant has amended claims **4, 11, 12, 13, 14, and 17**. Applicant has added claims **27-33**.
2. Pre-amendment A has been entered per applicant's request filed 04/27/04. Examiner was not aware of the Pre-amendment A since the amendment was not previously in the file wrapper.
3. Examiner **withdraws** the claim objection(s) for Office action filed 02/03/04. Examiner thanks applicant for making the necessary changes.
4. Examiner **withdraws** the 112-second paragraph rejection(s) for Office action filed 02/03/04. Examiner thanks applicant for making the necessary corrections to clarify the recited claimed subject matter and thus withdraws the rejection.
5. Examiner does **not withdraw** the anticipated rejection to *Sugita* for Office action filed 02/03/04. It appears at issue is the term "arbitrary timing" and in particular when "arbitrary timing" occurs. Specifically, applicant argues that *Sugita* does not teach "arbitrary timing" since the control circuit 66 in *Sugita* is constantly performing calculations and thereby wasting power. Applicant then goes on to state that one of the objects of applicant's invention is to reduce power consumption in mobile transmit and receiving circuits by interrupting code generation operation during a time period in which the code is not used for transmission or reception. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reduce power consumption in mobile transmit and receiving circuits by interrupting code generation operation during a time period in which the code is not used for transmission or reception) are not recited in the rejected claim(s).

Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Thus the examiner notes the above-issue is not recited in the claims. Specifically, examiner notes claims 3, 4, 17, 18, 23 and 24 do not clearly recite what happens during the step of an interrupting operation (i.e., that an interrupting operation is tied to “arbitrary timing” for which applicant attempts to argue). Furthermore, the above limitation is found in the dependent claims and not independent claims (thus it is unclear what is at issue with the independent claims). It is the examiner’s interpretation of the claims that the arbitrary timing of reading and writing to memory occurs since the code or phase varies (thus the timing is arbitrary). The interpretation is supported at least by column 7, lines 6-19. Finally, examiner notes that the statement reduce power consumption in mobile transmit and receiving circuits by interrupting code generation operation during a time period in which the code is not used for transmission or reception is taught at least at column 9, lines 23-42 of the reference.

As to newly added claims 27-33, it appears applicant attempts to clarify “arbitrary timing” by adding the further limitation that wherein the code generation means is started up at an arbitrary timing. Again, examiner notes that *Sugita* also teaches a clock that is continuous and thus “arbitrary” since values are read and written to and from memory based on the PN offset where the PN offset is “arbitrary” thus meeting the claim limitation(s). After careful review of applicants invention, it appears that applicant may be attempting to further argue an arbitrary time for a code generating means *after* a discontinuous transmission. In particular when the discontinuous code generation goes from an OFF to an ON state as taught in applicant’s figures 5 and 6. However, this transition is not recited in the claims for setup. As the clarification to the

claims appears to be the issue based on applicant's arguments, the examiner notes the further rejection below to clarify the examiner's position for the claims as necessitated by amendment. In particular, the new rejection has a slightly different interpretation of the claim which is more consistent with what applicant is arguing but may not be recited in the claims. The rejection is made final since the new rejection is based on applicant's claims as necessitated by amendment.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. **Claims 1-12, 15-26 and 27-33** are rejected under 35 U.S.C. 102(b) as being anticipated by EP 0744840 A2 to *Sony Corporation* (“Sony”) (cited in prior IDS as JP H8-321804).

As to **claim 1**, see figure 5 with respect to a PN code generator 62 and register(s).

Although *Sony* teaches generating a long PN code, the technique taught is still the same for the claim recitation. For example, with respect to a storing means, code generation means, and control means see e.g., column 9, lines 23-44. Specifically, examiner notes a reasonable but broad interpretation of “arbitrary timing”.

As to **claim 2**, see similar rejection for claim 1.

As to **claims 3-12**, see Section (3) Structure of Timing Controller and specifically column 9 in reference to figures 5, 7, and 8.

As to **claims 15-16**, see similar rejection for claim 1.

As to **claims 17-20**, see Section (3) Structure of Timing Controller and specifically column 9 in reference to figures 5, 7, and 8.

As to **claims 21-22**, see similar rejection for claim 1.

As to **claims 23-26**, see Section (3) Structure of Timing Controller and specifically column 9 in reference to figures 5, 7, and 8.

As to **claims 27-33**, see e.g., column 9, lines 23-42.

8. **Claims 1-6, 11, 12, 15-26 and 27-33** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,590,886 B1 to *Easton et al.* (“*Easton*”).

As such to **claim 1**, for step (a) *Easton* discloses a method and circuit for reducing the amount of time a mobile station spends in the active phase of a slot in a communications system utilizing a slotted paging mechanism, see e.g., column 3, lines 35-55. In particular, note the difference of the prior art shown in figure 2 in comparison with *Easton*’s invention in figure 3. Specifically, *Easton*’s invention uses “arbitrary timing” since the values for determining the wake period (and thus the reading and writing) are determined by the previous environment since the multipath environment may change when the mobile “wakes up”, see e.g., column 3, lines 23-32 and column 6, lines 43-60. Although a receiver is shown in figure 1 a transmitter is simply the reverse of the receiver.

As to **claim 2**, see similar rejection to claim 1.

As to **claims 3-6**, see figure 3.

As to **claims 11 and 12**, see combined rejection to claims 1 and 2.

As to **claims 15**, see similar rejection to claim 1.

As to **claims 16**, see similar rejection to claim 2.

As to **claims 17-20**, see similar rejection to claims 3-6 respectfully.

As to **claims 21**, see similar rejection to claim 1.

As to **claims 22**, see similar rejection to claim 2.

As to **claims 23-26**, see similar rejection to claims 3-6 respectfully.

As to **claims 27-33**, the startup time is different since the offset may change when  
the mobile wakes up, see e.g., column 6, lines 42-60.

***Allowable Subject Matter***

9. **Claim 13** is objected to as being dependent upon a rejected base claim, but would be  
allowable if rewritten in independent form including all of the limitations of the base claim and  
any intervening claims.

10. **Claim 14** is allowable.

***Conclusion***

11. The prior art made of record and not relied upon is considered pertinent to applicant's  
disclosure

- US006263010B1 discloses that it is well known in the art that the initial timing of code  
generator is arbitrary, see column 1, lines 63-67.

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris  
Examiner  
Art Unit 2663

  
DWF

  
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SUPERVISORY PATENT EXAMINER  
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